



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,215	04/28/2000	Max Levchin	X00-001	3676

7590

01/15/2002

Park & Vaughan
702 Marshall Street
Suite 310
Redwood City, CA 94063-1824

EXAMINER

MILLIN, VINCENT A

ART UNIT

PAPER NUMBER

2164

DATE MAILED: 01/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/560,215 04/28/00 LEVCHIN

TM02/1011

PARK & VAUGHAN
399 SHERMAN AVENUE
SUITE 5
PALO ALTO CA 94306

EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

DATE MAILED:

10/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/560,215

Applicant(s)
LEVCHIN, Max et al

Examiner
Jim Calve

Art Unit
2164



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 28, 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Apr 28, 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4, 5 20) ☐ Other:

Art Unit: 2164

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It was not executed in accordance with either 37 CFR 1.66 or 1.68. Mr. Levchin did not date the declaration when he signed it.

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: state 212 (e.g., page 19, line 4 et seq of the application). Correction is required.

Art Unit: 2164

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "210" has been used to designate both "IS USER2 REGISTERED?" and "USER2 IS REGISTERED WITH SYSTEM" in Figure 2. Correction is required.

Specification

5. The abstract of the disclosure is objected to because the length of the abstract exceeds 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 1-3, 20-23 26, 34, and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Downing et al, U.S. patent 5,963,647.

Downing et al disclose a method and system for facilitating value exchange (e.g., Figures 2, 3), including registering a first user and receiving a value exchange from a first user involving a second user (e.g., column 3, line 40 et seq; column 6, line 9 et seq), pre-existing second user identifier (e.g., secret code, password) (e.g., column 5, line 15 et seq), independently usable (e.g., recipient's name/address) (e.g., Figure 3; column 6, line 20 et seq; column 8, line 57

Art Unit: 2164

et seq; column 9, line 36 et seq), value (e.g., cash access file), notifying the second user and allocating value (e.g., column 3, line 54 et seq; column 7, line 5 et seq), registering second user (e.g., column 7, line 29 et seq; column 9, line 65 et seq), as broadly recited and disclosed (e.g., Figure 2; page 18, line 20 to page 19, line 12 of the application), user database (e.g., inherently disclosed) (e.g., Figure 2; column 5, line 23 et seq), synchronization server (e.g., column 5, line 60 et seq; column 6, line 48 et seq), and communication server to register second user (e.g., Figures 6A, 6B; column 5, line 47 et seq; column 12, line 10 et seq).

Downing et al also disclose registering second user (e.g., accepting name, codeword and authorization code) (e.g., Figures 6A, 6B; column 5, line 47 et seq; column 12, line 10 et seq), as broadly recited and disclosed (e.g., Figure 2; page 18, line 20 to page 19, line 12 of the application), value transfer from first to second user (e.g., column 7, line 17 et seq), value/currency conversion (e.g., column 9, line 22 et seq), pre-existing identifier (e.g., recipient's name/address) (e.g., Figure 3; column 6, line 20 et seq; column 8, line 57 et seq; column 9, line 36 et seq), escrow (e.g., column 8, line 45 et seq), financial institution (e.g., column 3, line 40 et seq; column 4, line 47 et seq).

8. Claims 1-3, 5, 6, 8, 11, 25, 26, 27, and 34-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Doggett et al, U.S. patent 5,677,955.

Doggett et al disclose a method and system for facilitating value exchange, including registering a first user (e.g., column 4, line 37 et seq), receiving a value exchange transaction from a first user (e.g., column 7, line 49 et seq), pre-existing second user identifier (e.g., name, e-mail

Art Unit: 2164

address, account) (e.g., Figures 3, 5; column 7, line 20 et seq; column 9, line 36 et seq), notifying second user of value exchange and allocating value (e.g., column 7, line 65 et seq), registering a second user (e.g., column 12, line 53 et seq), as broadly recited and disclosed (e.g, Figure 2; page 18, line 20 to page 19, line 12 of the application), database (e.g., Figure 3; column), synchronization server (e.g., at 90) (Figure 4; column 8, line 60 et seq), communication server (e.g., 92) (Figure 4).

Doggett et al also disclose second user registration (e.g., column 12, line 53 et seq), as broadly recited and disclosed (e.g, Figure 2; page 18, line 20 to page 19, line 12 of the application), asymmetric cryptography (e.g., column 4, line 59 et seq), transfer from first to second user (e.g., Figure 4), redeemable voucher (e.g., deposit instrument 160) (Figure 6; column 12, line 66 et seq), electronic link (e.g., Figure 3; column 4, line 37 et seq; column 13, line 13 et seq), debit card (e.g., column 16, line 59 et seq; column 17, line 4 et seq), e-mail address (e.g., Figure 3; column 7, line 20 et seq; column 9, line 36 et seq), financial server (e.g., column 10, line 22 et seq), security server for digital identity and transaction certificates (e.g., column 3, line 30 et seq; column 11, line 47 et seq; column 18, line 45 et seq; column 20, line 10 et seq).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2164

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4, 9, 10, 24, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett et al, U.S. patent 5,677,955.

Doggett et al disclose a method and system for facilitating value exchange between a first and second user based on pre-existing identifiers (e.g., name, e-mail address, account number), as discussed, and including a user telephone number (e.g., column 13, line 1 et seq; cf., column 10, line 5 et seq) and web certificate (e.g., column 13, line 12 et seq; column 14, line 56 et seq). To the extent that Doggett et al could be interpreted not to disclose a telephone number user identifier or value exchange from a second user to a first/third user (e.g., by second user endorsing the electronic check to a third party or other user), it would have been obvious to one of ordinary skill in the art at the time of the invention to use a telephone number as an additional means of identifying a second user to facilitate a value exchange therewith (e.g., via dial up or wireless connection) (e.g., Figure 3; column 13, line 1 et seq; cf., column 10, line 5 et seq) and to provide a means for a second user to exchange value with a first user or third user to facilitate commercial transactions between the second user and others (e.g., bill/invoice presentment by a first user, such as a merchant or utility, to a second user/consumer who exchanges value in payment thereof, or endorsement of a received value exchange by a second user to a third user to whom the second user is indebted).

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett et al, U.S. patent 5,677,955, in view of Remington et al, U.S. patent 6,070,150.

Art Unit: 2164

Doggett et al disclose a method and system for facilitating value exchange, including the use of a redeemable voucher, as discussed. Doggett et al do not disclose an electronic advertisement. Remington et al disclose a method and system for facilitating value exchange, including a voucher with an electronic advertisement (e.g., 213) (e.g., Figure 7; column 10, line 29 et seq). Providing advertisements with vouchers and other commercial documents provides an improved marketing means to target specific product and service offerings to consumers (e.g., column 12, line 41 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the redeemable vouchers of Doggett et al with electronic advertisements, as taught by Remington et al, to market relevant products and services to users involved in value exchanges.

12. Claims 12-19 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett et al, U.S. patent 5,677,955, in view of Nikander, U.S. patent 6,029,151.

Doggett et al disclose a method and system for facilitating value exchange, including registering a first user (e.g., column 4, line 37 et seq), receiving a value exchange transaction from a first user (e.g., column 7, line 49 et seq), pre-existing second user identifier (e.g., name, e-mail address, account) (e.g., Figures 3, 5; column 7, line 20 et seq; column 9, line 36 et seq), notifying second user of value exchange and allocating value (e.g., column 7, line 65 et seq) and what could be considered to be "mobile communications" (e.g., screen phone) (e.g., Figure 10; column 15, line 33 et seq) and wireless network (e.g., 65) (Figure 3; column 7, line 20 et seq). To the extent that Doggett et al could be interpreted not to disclose "mobile communications," Nikander

Art Unit: 2164

discloses a method and system for facilitating value exchange with mobile communications devices (e.g., Figure 6). Mobile communication value exchange systems provide improved, convenient means to conduct value exchange transactions from remote locations (e.g., Nikander, column 11, line 57 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide mobile communications, as taught by Nikander, on the value exchange method and system of Doggett et al to provide a means for users to exchange value at convenient times and locations.

Doggett et al do not disclose particular mobile communication devices. Nikander discloses a plurality of disconnectable mobile communication devices (e.g., Figure 6), including a PDA (206), telephone (202), and wireless network (Figure 6). Mobile communication value exchange systems provide improved, convenient means to conduct value exchange transactions from remote locations (e.g., column 11, line 57 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a mobile communication value exchange system, as taught by Nikander, on the method and system of Doggett et al to provide a means for users to exchange value at convenient times and locations. Regarding claim 17, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide mobile communications using a two-way pager as a means to increase flexibility of use of the system and method of Doggett et al. Regarding claim 33, Doggett et al disclose a second user telephone number (e.g., column 13, line 1 et seq; cf., column 10, line 5 et seq). To the extent that Doggett et al could be interpreted not to disclose a telephone number user identifier, it would

Art Unit: 2164

have been obvious to one of ordinary skill in the art at the time of the invention to use a telephone number as an additional means of identifying a second user to facilitate a value exchange therewith (e.g., via dial up or wireless connection) (e.g., Figure 3; column 13, line 1 et seq; cf., column 10, line 5 et seq).

13. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doggett et al, U.S. patent 5,677,955, in view of Downing et al, U.S. patent 5,963,647.

Doggett et al disclose a method and system for facilitating value exchange, as discussed. To the extent that Doggett et al could be interpreted not to disclose value conversion based on a pre-existing user identifier or escrow, Downing et al disclose a method and system for facilitating value exchange, including value/currency conversion (e.g., column 9, line 22 et seq) based on a pre-existing user identifier (e.g., address) (e.g., column 6, line 18 et seq) and escrow (e.g., column 8, line 45 et seq). Value/currency conversion based on a pre-existing identifier provides an improved means to facilitate international value exchanges (e.g., column 6, line 30 et seq), while escrowed exchanges provide an improved means to control funds until a value exchange has concluded (e.g., column 3, line 65 et seq; column 8, line 3 et seq).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

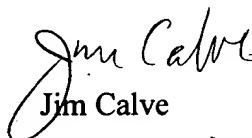
a. Kasai et al, U.S. patent 6,058,382 disclose a value exchange system.

Art Unit: 2164

- b. Hilt et al, U.S. patent 6,032,133 disclose a value exchange system with mobile communications (e.g., column 11, line 45 et seq).
- c. Konya, U.S. patent 5,937,396 discloses a value exchange system.
- d. Bernstein, U.S. patent 5,915,023 discloses a value exchange system with personal identifiers (e.g., column 8, line 30 et seq).
- e. Biffar, U.S. patent 5,903,880 discloses a value exchange system of vouchers.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim Calve, whose telephone number is (703) 308-1884. The examiner can be reached on Monday through Friday from 6:45 am to 6:45 pm. The fax number of the organization is 703-308-9051/9052. Any inquiry of a general nature should be directed to the receptionist at 703-305-3900.

Respectfully submitted,


Jim Calve

September 28, 2001